

REMARKS

The Examiner has rejected Claims 16, 18-25, 28, 32 and 33 under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane. Claim 17 was rejected under 35 U.S.C. 103(a) Bailey et al. in view of Crane and further in view of Ward et al. Claims 29-31 were rejected under 35 U.S.C. 103(a) over Bailey et al. in view of Crane and further in view of Cox. Finally, claim 32 was also rejected under 35 U.S.C. §112, second paragraph. Applicants have amended Claim 32 and believe that the Section 112 rejection is now moot.

Claims 16, 18-25, 28, 32 and 33

Applicants respectfully submit that the Examiner has misconstrued the teachings of Bailey, et al. and Crane in arriving at the conclusion that it would be obvious to combine Bailey and Crane to arrive at the claimed invention.

As noted by the Examiner, Bailey, et al. discloses an elastic cord or intermediate member having hooks which, as shown in Figure 2 of Bailey, engage the reinforced, inner spine of the book. This is described in the Bailey et al. specification as follows: "This cord is provided at each end with a hook or other fastening c, which engages the leaves of the book at each end, thus holding the cord or support in the fold or bend of the book-back" (Bailey, Col. 2 lines 67-71) Thus, the book indicator of Bailey, et al., engages the inner spine of the book to hold the cord within the fold at the book back. This is accomplished by hooks or fasteners which actually engage or fasten to the spine.

Applicants respectfully submit that the hooks of Bailey are not the same as the anchors of Claims 16 and 32, the three-dimensional stops of Claim 30, and 32 or the three-dimensional first and second members of Claim 33.

As described in the specification and claimed, the anchors, stops and members of Claims 16, 30, 32 and 33 are thicker than the intermediate member such that when the intermediate member is placed between the pages of a book the thicker anchors, stops or members inhibit or prevent the bookmark from being removed in a direction parallel to the book spine.

The removal of the bookmark is inhibited by the anchor, stops or members abutting up against the outside ends of the pages of the book. Applicants respectfully submit that this is not taught or suggested by Bailey. To the contrary Bailey's use of "hooks or fasteners" teaches the use of elements which engage or fasten to the spine of the book.

As for the Examiners position that Crane teaches a bookmark having abutment members and that it would be obvious to modify Bailey by placing the "abutment members" of Crane to the hooks of Bailey, Applicants submit that this would not result in the claimed invention. In such a combination, the abutment members would be mere ornamentation with the intermediate member still being held in place by the hooks engaging the spine portion of the book. The removal of the intermediate portion would not be inhibited by the Crane abutment members. In that regard, Applicants note the Examiner's contention that the hooks of Bailey are abutments. Applicants respectfully disagree. The hooks of Bailey, et al. engage the spine of the book at the rear fold portion of the book. They do not about the outside edges of the ends of the pages. Indeed if the

Bailey device were positioned away from the reinforced spine portion of the book the device would not function as the claimed invention.

Furthermore, to the extent the hooks of Bailey are "abutments" they are positioned internal of the book and not external of the ends of the book as in the subject invention.

Thus, contrary to the Examiner's position the combination of Bailey, et al. and Crane would not lead to the claimed invention. Additionally, Applicants submit Crane does not disclose abutment members. As shown in Crane the head and feet portions of the bookmark appear to be the same thickness as the intermediate ribbon portion.

Furthermore, since Bailey, et al., operates by hooks (c) engaging or fastening to the spine of the book there is absolutely no need for or suggestion to provide abutment means on the hooks to inhibit removal of the book indicator. As the Examiner is aware there must be some suggestion in the art relied upon to combine the references, In this instance Applicants submit that the Examiner is improperly using Applicants disclosure as a roadmap on how to combine Bailey, et al. and Crane.

Therefore, Applicants respectfully submit that the Examiners rejection of Claims 16, 18-25, 28, 32 and 33 should be withdrawn.

Claims 17 and 29-31

Claims 17 and 29-31 were rejected over the same combination of Bailey, et al. and Crane as the claims discussed above. Therefore, Applicants submit that said claims are allowable for the same reasons discussed above.

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please enter the following new paragraph at page 1 of the specification.

--This application is a continued prosecution application of Application Serial No. 09/595,515, filed on June 15, 2000, which is a continuation application of Application Serial No. 09/136,348, filed on August 19, 1998, now abandoned.--

IN THE CLAIMS:

32. (Twice Amended) A bookmark for use in between pages of a book having a spine and a binding comprising:

a flexible, elongated, intermediate member having a first end and an opposing second end, said member having a predetermined length and thickness, said thickness being of a size to allow said intermediate member to extend between the pages of the book and along the length of the spine of the book without stretching its binding;

5 a top anchor having a thickness greater than the thickness of the intermediate member and being in the form of the upper body [a] portion of a character including a head end secured to said first end;

10 a bottom anchor having a thickness greater than the thickness of the intermediate

member and being in the form of the lower body [a second] portion of said character [complementing said first portion end] secured to said second end; and

wherein said anchors inhibit removal of the bookmark in a direction parallel to the length of the spine when the bookmark is inserted between the pages of the book.

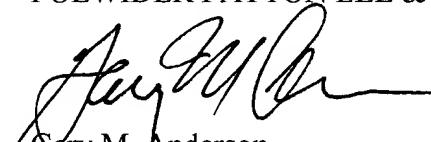
CONCLUSION

Applicants respectfully submit that the Examiner's rejection of Claims 16-25 and 28-33 based upon Bailey, et al. and Crane is improper and should be withdrawn. Applicants earnestly request the issuance of a Notice of Allowance. If there are any remaining informalities to be addressed in order to put the application in condition for allowance a telephonic interview with the Examiner is requested.

Please charge any additional fees payable in connection with this Amendment to Deposit Account No. 21-0800.

Sincerely,

FULWIDER PATTON LEE & UTECHT, LLP



Gary M. Anderson
Registration No. 30,729

GMA:srp
Fulwider Patton Lee & Utecht, LLP
200 Oceangate, Suite 1550
Long Beach, California 90802
(562) 432-0453

Customer No:



27629

PATENT TRADEMARK OFFICE